



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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### MEMORANDUM

**DATE:** November 4, 2002

**TO:** Technology Center Directors

**FROM:** Stephen G. Kunin  
Deputy Commissioner for Patent Examination Policy

**SUBJECT:** Revision to 35 U.S.C. § 102(e)

**Summary:** The recently enacted amendments to 35 U.S.C. § 102(e) make several changes to determining prior art under § 102(e). The revised provisions allow the use of certain WIPO and U.S. application publications and certain U.S. patents as prior art under 35 U.S.C. § 102(e) as of their respective U.S. filing dates, including certain international filing dates. The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and, **effective immediately, must always** be applied in making patentability determinations in any application being examined or patent being reexamined. Thus, the newly amended § 102(e) completely nullifies the changes to § 102(e) made by the AIPA. Accordingly, the filing date of the application being examined (or patent being reexamined) no longer determines which version of 35 U.S.C. § 102(e) is used. The disclosure of an application that is issued as a U.S. patent, or published as a U.S. application publication, or a WIPO publication of an international (PCT) application (IA), will be applied as prior art as of the same prior art date unless the application is an IA filed before November 29, 2000, or it claims the benefit of the filing date of an IA filed before November 29, 2000.

#### **Prior Art Dates:**

**Non-IA U.S. filing dates as prior art dates:** U.S. application publications and U.S. patents, that did **not** result from the national stage of an IA (*i.e.*, did not result from a 35 U.S.C. § 371 application) and that do **not** claim the benefit of a prior IA, may be applied as prior art as of the actual filing date under 35 U.S.C. § 111(a), or any filing date claimed under 35 U.S.C. §§ 119(e) or 120\*.

**IA filing dates as prior art dates:** The most significant change to 35 U.S.C. § 102(e) is that certain IA filing dates are U.S. filing dates for prior art purposes. U.S. and WIPO application publications and U.S. patents, which are derived from IAs or claim the benefit of IA filing dates\* (per 35 U.S.C. § 365(c)), may be applied as prior art as of the IA filing dates but only if all of the following conditions are true:

- The international filing date is: **on or after November 29, 2000**;
- The IA **designated the U.S.**; and
- The IA was **published in English**.

If an IA meets the above conditions, a further claim of benefit in the IA will enable the prior art date to be any date claimed under 35 U.S.C. §§ 119(e), 120, or 365(c)<sup>1\*</sup>.

\* Use of the earlier application's filing date is appropriate only if the relied upon application(s) supports the subject matter used to make the rejection. See MPEP 2136.03 parts III and IV.

**The Exception:** Patents issued from IAs filed prior to **November 29, 2000** may be applied as of the date of compliance with 35 USC § 371(c)(1), (2) and (4). U.S. application publications and WIPO publications of IA's filed prior to **November 29, 2000** may not be applied as of the IA filing date or the § 371(c)(1),(2) and (4) date.

**Foreign priority:** While applications that have been published as U.S. or WIPO application publications, or patented in the U.S., may have proper priority claims to foreign applications per 35 U.S.C. §§ 119(a)-(d) or 365(a), the foreign applications' filing dates may never be used as the prior art dates of such publication or patent references. This would, similarly, preclude usage of international filing dates when they are claimed as foreign priority dates under 35 U.S.C. § 365(a).

**Implementation Issues:**

**Final rejection practice:** If a second or subsequent action contains a new ground of rejection necessitated by the change to 35 U.S.C. § 102(e) that was not also necessitated by an amendment to the claims or as a result of certain information disclosure statements (See MPEP 706.02(a)), that action cannot be made final. See MPEP 706.07(a).

**Implementation Materials:** To help examiners understand the revised provisions of § 102(e), and to facilitate the transition to the examination practices to be followed now that the revised § 102(e) is always applicable, the following materials are being provided:

- Appendix I: Examination Guidelines (O.G. Notice)
- Appendix II: Training slides with a number of examples
- Appendix III: Flowchart to determine prior art applicability
- Appendix IV: Revised Form Paragraphs (e-version to be available prior to OACS revision)

The MPEP and the form paragraphs in OACS shall be revised to adopt these materials in due course.

**Further Assistance:** Contact Rob Clarke (305-9177), Senior Legal Advisor, or Jeanne Clark (306-5603), Legal Advisor, OPLA, if you have any questions or desire assistance for special circumstances. Alternately, you may send an e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures.

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<sup>1</sup> If the parent and child applications are IAs, both of the IAs must satisfy the three conditions to be applied as of the earlier IA filing date.